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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,636	02/06/2004	George E. Berkey	SP00-386A	8345
22928	7590	12/17/2004	EXAMINER	
CORNING INCORPORATED			DOAN, JENNIFER	
SP-TI-3-1			ART UNIT	
CORNING, NY 14831			PAPER NUMBER	
			2874	

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/773,636

Applicant(s)

BERKEY ET AL.

Examiner

Jennifer Doan

Art Unit

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17-20, 22-34, 36, 37 and 39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17-20, 22-33, 36, 37 and 39 is/are allowed.
- 6) ☒ Claim(s) 34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>020604</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The prior art documents submitted by applicant in the Information Disclosure Statement filed on 02/06/2004, have all been considered and made of record (note the attached copy of form PTO-1449).

### ***Drawings***

2. The drawings, filed on 02/06/2004, are accepted.

### ***Specification***

3. Applicants' cooperation is requested in correcting any errors of which applicants may become aware in the specification.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Campion et al.* (U.S. Patent 6,201,917).

With respect to claim 34, *Campion et al.* (figure 3 and column 7, lines 3-7) disclose a low water peak, hydrogen resistant optical waveguide fiber, the fiber (15) comprising a silica containing glass core (30); and a glass cladding (31) surrounding the silica containing glass core (30).

*Campion et al.* do not explicitly disclose the optical waveguide fiber exhibits an optical attenuation of less than about 0.36 dB/km at each wavelength within a wavelength range from about 1300 nm to about 1600 nm after being subjected to a 0.01 atm hydrogen partial pressure for at least 144 hours.

However, the optical waveguide fiber exhibiting an optical attenuation of less than about 0.36 dB/km at each wavelength within a wavelength range after being subjected to a 0.01 atm hydrogen partial pressure for at least 144 hours is considered to be obvious, since the efficiency of the optical transmission is

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dependent on the attenuation of the optical fiber. Such an element would advantageously provide a highly efficient transmission of optical signal.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the optical waveguide fiber of Campion's device exhibiting an optical attenuation of less than about 0.36 dB/km at each wavelength within a wavelength range after being subjected to a 0.01 atm hydrogen partial pressure for at least 144 hours for the purpose of obtaining the highly efficient transmission of optical signal, and it also has been held that discovering an optimum value of a result effective variable involves only routine skill in the art and it is noted that the applicant does not disclose criticality in the value claimed. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980) (see MPEP § 2144.05).

***Allowable Subject Matter***

7. Claims 17-20, 22-33 and 39 are allowed.

The prior art of record fails to disclose or reasonably suggest a method and an apparatus of dispersion compensation system, wherein the optical waveguide fiber exhibits an optical attenuation at a wavelength of about 1383 nm which is less than or equal to an optical attenuation exhibited at a wavelength of about 1310 nm as recited in claim 17.

Claims 18-20, 22-33 and 39 are dependent on the allowable claim 17.

Therefore, claims 18-20, 22-33 and 39 are also allowed.

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Claims 36-37 are allowed.

The prior art of record fails to disclose or reasonably suggest a method and an apparatus of dispersion compensation system, wherein the optical waveguide fiber exhibits an optical attenuation at a wavelength of about 1383 nm which is not more than 0.10 dB/km above an optical attenuation exhibited at a wavelength of about 1310 nm as recited in claim 36.

Claim 37 is dependent on the allowable claim 36. Therefore, claim 37 is also allowed.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Doan whose telephone number is (571) 272-2346. The examiner can normally be reached on Monday to Thursday from 6:00 am to 3:30 pm, second Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rodney Bovernick can be reached on (571) 272-2344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair->

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direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in cursive script that reads "Jennifer Doan".

Jennifer Doan

Patent examiner

December 9, 2004